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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,220	01/09/2004	David S. Singer	POU920030174US1	8036
23334 7590 07/27/2007 FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			EXAMINER PATEL, HARESH N	
			ART UNIT 2154	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/754,220	SINGER, DAVID S.	
	Examiner	Art Unit	
	Haresh Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/9/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are subject to examination.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title, "Identification of spoofed email", is too broad and is not sufficient for proper classification of the claimed subject matter.

Drawings

3. The figures submitted on 1/9/2004 are acknowledged.

Information Disclosure Statement

4. An initialed and dated copy of the applicant's IDS form 1449, paper dated 1/9//2004, is attached to the instant Office action.

Claim Objections

5. Claims 5, 8, 15, 20 are objected to because of the following informalities:

Claims 5, 8, 15, 20, mentions, "and/or", which should be --or--

Claim20 is missing --- after "with the first network"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The specification of this application under examination does not define "storage medium". Note: the specification defines "computer readable medium" including signal/carrier wave, which is non-statutory.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-20 recite the limitations, "it" and/or "its". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim. Note: usage of "if" statement also includes condition that is not satisfied, as compared to the usage of "when".

The term "original" in claims 9 and 16 is a relative term, which renders the claim indefinite.

Claim Rejections - 35 USC § 102

Art Unit: 2154

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by 2004/0148356, Bishop JR et al., AutoUptodate (Hereinafter Bishop-AutoUptodate).

10. Referring to claims 1, 10, 17 Bishop-AutoUptodate discloses a method, a computer system and a computer program product for identifying spoofed emails (e.g., col., 4) comprising a storage medium readable by a processing circuit and storing instructions for execution by the processing circuit for performing a method comprising (e.g., col., 4), a receiver receiving an email addressed to a recipient in a first network (e.g., col., 6), the email including a plurality of headers (e.g., col., 6), wherein at least one of the plurality of headers includes a sender address (e.g., col., 6); a processor determining whether the sender address indicates a mailbox from within the first network (e.g., col., 22); modifying the sender address if it indicates a mailbox from within the first network (e.g., col., 22); and a transmitter sending the email with the modified sender address to the recipient (e.g., col., 22).

11. Referring to claims 2, 11, 18, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses receiving the email that includes a "sender" header field that includes the sender address (e.g., col., 6).

12. Referring to claims 3, 12, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses wherein the receiving step comprises: receiving the email that includes a "from" header field that includes the recipient's address (e.g., col., 7).

13. Referring to claim 4, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses wherein the receiving step comprises: receiving the email that includes a "reply-to" header that includes the sender address (e.g., col., 7).

14. Referring to claims 5, 6, 13, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses wherein the step of determining comprises: the processor determining whether the sender address matches any one of a plurality of domains and/or sub-domains associated with the first network (e.g., col., 7) and the step of modifying comprises: the processor modifying the sender address if it matches any one of the domains and/or sub-domains associated with the first network (e.g., col., 7).

15. Referring to claims 7, 14, 19, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses wherein the step of modifying comprises: the

Art Unit: 2154

processor modifies the sender address by appending a predetermined sub-domain to the sender address (e.g., col., 7).

16. Referring to claims 8, 15, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses wherein the step of modifying comprises: modifying a domain and/or sub-domain of the sender address (e.g., col., 7).

17. Referring to claims 9, 16, Bishop-AutoUptodate discloses the claimed limitations as above. Bishop-AutoUptodate also discloses receiving a second email, the second email being from the recipient and being addressed to the modified sender address (e.g., col., 18); modifying the modified sender address so as to return it to its original form; and sending the second email (e.g., col., 18).

18. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by 2003/0233418, Goldman (Hereinafter Goldman).

19. Referring to claims 1, 10, 17 Goldman discloses a method, a computer system and a computer program product for identifying spoofed emails (e.g., col., 3) comprising a storage medium readable by a processing circuit and storing instructions for execution by the processing circuit for performing a method (e.g., col., 3) comprising, a receiver receiving an email addressed to a recipient in a first network (e.g., col., 3), the email including a plurality of headers (e.g., col., 4), wherein at least one of the plurality of headers includes a sender address; a processor

Art Unit: 2154

determining whether the sender address indicates a mailbox from within the first network (e.g., col., 6); modifying the sender address if it indicates a mailbox from within the first network (e.g., col., 6); and a transmitter sending the email with the modified sender address to the recipient (e.g., col., 6).

20. Referring to claims 2, 11, 18, Goldman discloses the claimed limitations as above.

Goldman also discloses receiving the email that includes a "sender" header field that includes the sender address (e.g., col., 4).

21. Referring to claims 3, 12, Goldman discloses the claimed limitations as above. Goldman also discloses wherein the receiving step comprises: receiving the email that includes a "from" header field that includes the recipient's address (e.g., col., 4).

22. Referring to claim 4, Goldman discloses the claimed limitations as above. Goldman also discloses wherein the receiving step comprises: receiving the email that includes a "reply-to" header that includes the sender address (e.g., col., 4).

23. Referring to claims 5, 6, 13, Goldman discloses the claimed limitations as above. Goldman also discloses wherein the step of determining comprises: the processor determining whether the sender address matches any one of a plurality of domains and/or sub-domains associated with the first network (e.g., col., 6) and the step of modifying comprises: the processor

Art Unit: 2154

modifying the sender address if it matches any one of the domains and/or sub-domains associated with the first network (e.g., col., 6).

24. Referring to claims 7, 14, 19, Goldman discloses the claimed limitations as above.

Goldman also discloses wherein the step of modifying comprises: the processor modifies the sender address by appending a predetermined sub-domain to the sender address (e.g., col., 9).

25. Referring to claims 8, 15, Goldman discloses the claimed limitations as above. Goldman also discloses wherein the step of modifying comprises: modifying a domain and/or sub-domain of the sender address (e.g., col., 9).

26. Referring to claims 9, 16, Goldman discloses the claimed limitations as above. Goldman also discloses receiving a second email (e.g., col., 6), the second email being from the recipient and being addressed to the modified sender address (e.g., col., 6); modifying the modified sender address so as to return it to its original form; and sending the second email (e.g., col., 6).

27. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by 2004/0193691, Chang, Affini Inc. (Hereinafter Chang-Affini).

28. Referring to claims 1, 10, 17 Chang-Affini discloses a method, a computer system and a computer program product for identifying spoofed emails comprising a storage medium readable

Art Unit: 2154

by a processing circuit and storing instructions for execution by the processing circuit for performing a method (e.g., col., 2) comprising, a receiver receiving an email addressed to a recipient in a first network (e.g., col., 2), the email including a plurality of headers (e.g., col., 5), wherein at least one of the plurality of headers includes a sender address (e.g., col., 5); a processor determining whether the sender address indicates a mailbox from within the first network (e.g., col., 5); modifying the sender address if it indicates a mailbox from within the first network (e.g., col., 5); and a transmitter sending the email with the modified sender address to the recipient (e.g., col., 5).

29. Referring to claims 2, 11, 18, Chang-Affini discloses the claimed limitations as above. Chang-Affini also discloses receiving the email that includes a "sender" header field that includes the sender address (e.g., col., 2).

30. Referring to claims 3, 12, Chang-Affini discloses the claimed limitations as above. Chang-Affini also discloses wherein the receiving step comprises: receiving the email that includes a "from" header field that includes the recipient's address (e.g., col., 2).

31. Referring to claim 4, Chang-Affini discloses the claimed limitations as above. Chang-Affini also discloses wherein the receiving step comprises: receiving the email that includes a "reply-to" header that includes the sender address (e.g., col., 2).

Art Unit: 2154

32. Referring to claims 5, 6, 13, Chang-Affini discloses the claimed limitations as above.

Chang-Affini also discloses wherein the step of determining comprises: the processor determining whether the sender address matches any one of a plurality of domains and/or sub-domains associated with the first network (e.g., col., 5) and the step of modifying comprises: the processor modifying the sender address if it matches any one of the domains and/or sub-domains associated with the first network (e.g., col., 5).

33. Referring to claims 7, 14, 19, Chang-Affini discloses the claimed limitations as above.

Chang-Affini also discloses wherein the step of modifying comprises: the processor modifies the sender address by appending a predetermined sub-domain to the sender address (e.g., col., 5).

34. Referring to claims 8, 15, Chang-Affini discloses the claimed limitations as above.

Chang-Affini also discloses wherein the step of modifying comprises: modifying a domain and/or sub-domain of the sender address (e.g., col., 5).

35. Referring to claims 9, 16, Chang-Affini discloses the claimed limitations as above.

Chang-Affini also discloses receiving a second email, the second email being from the recipient and being addressed to the modified sender address (e.g., col., 6); modifying the modified sender address so as to return it to its original form (e.g., col., 7); and sending the second email (e.g., col., 7).

Conclusion

Multiple references are used for the rejections to demonstrate that several references disclose the broadly claimed subject matter of the claims.


Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Haresh Patel

Haresh Patel

7/22/07